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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,336	08/27/2003	Michael Gadd	17087/002001	4679

7590 07/25/2006

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EXAMINER

HAN, QI

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,336	GADD ET AL.	
	Examiner	Art Unit	
	Qi Han	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the applicant's amendment dated 05/17/2006.

Applicant added new claim 31.

Election/Restrictions

2. Applicant's election with traverse of invention Group I in the reply filed on 05/17/2006 is acknowledged. The traversal is on the ground(s) that “the spoken language interface system is related to the development tool of claims 25-31 as a product and tool for making the product” and “the method of claims 20-24 is related to the language interface mechanism of claims 1-19 as a product and method of using the product”, and “claims 1-19 and ...claims 25[15]-31 are not related as combinations and subcombinations” and method of claims 20-24 “is not related as a combination and subcombination with the development tool produces as recited in claims 25-31” (the amendment: pages 8-9). This is not found persuasive because applicant fails to correctly respond the examiner's election/restriction requirement based on the reason that “the **inventions are distinct**, each from the other because ...the Group I (claims 1-24) and Group II (claims 25-30) are **related as subcombinations disclosed as usable to together in a single combination**” (see detail in the office action filed on 04/18/2006), which is not the same basis as applicant argued above. Further, in fact, the applicant's new added claim 31 (see the amendment: pages 6-7) combines the features of the spoken language interface and features of the development tool together as a single claim, which provides an evidence of the reason for restriction within the same scope as stated in the previous office action that “the inventions are distinct, each from the other ...the Group I (claims 1-24) and Group II (claims 25-30) are related as subcombinations

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disclosed as usable to together in a single combination”. For above reason, the requirement is still deemed proper and is therefore made **FINAL**.

3. Claim 25-30 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention Group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 05/17/2006.

4. Newly submitted claim 31 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Regarding new added independent claim 31, it drawn to an invention that combines features of inventions I and II together as a single claim, which is distinct from invention groups I and II that have separate utility respectively, as described in the previous office action (see detail in Paper filed on 04/18/2006).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits (also see Response to Election / Restriction Filed 05/17/2006). Accordingly, **claim 31 withdrawn** from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-10, it recites “a spoken language interface mechanism”, without a computer readable medium and any interrelationship to any hardware/structural components, so that the claimed invention is treated as pure software (program), which is descriptive material. It is noted that descriptive material per se, such as computer program (software) without embodied in (or encoded with) computer-readable medium, is neither computer components nor statutory process. Therefore, it is directed to non-statutory subject matter and lacks patentable utility. It is also noted that, since a computer program (software) is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material (see MPEP 2106.IV.B.1.(a).)

Regarding claim 11, it recites “a computer system” referring to claim 1. The rejection is based on the same reason described for claim 1, because herein the computer system is interpreted as software system (program per se) as claim 1.

Regarding claim 12, it recites “a program element” referring to claim 1. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material (see MPEP 2106.IV.B.1.(a).)

Regarding claim 13, it recites “a computer program product” referring to claim 12. The

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rejection is based on the same reason described for claim 12, because herein the computer program product is only claimed as software per se as claim 12.

Regarding claims 14-16, it recites “a computer program product on a carrier medium”, wherein the carrier medium is interpreted as signal (see claim 16). Since signal is nonstatutory natural phenomena, O’RillyV. Morse 56 U.S. (1853), the claimed subject matter is not patentable. The rejection is also based on the same reason described for claim 12, because the claims are treated as computer program per se as claim 12.

Regarding claims 17-19, it recites “a spoken language system”. The rejection is based on the same reason described for claim 1-10, since the claims 17-19 recite the same or similar limitation as claims 1-10.

Regarding claims 20-24, it recites “a method”. Since the claimed method, in light of specification, is based on the computer software implementation as described for claims 1-10, the claim is rejected within the same scope and rationale as claims 1-10.

7. To expedite a complete examination of the instant application the claims rejection under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the claimed limitation of “**non-directed dialogue**” lacks clear definition in the specification (see closest disclosure in paragraphs 31 and 47) and is not commonly accepted terms in the art, so that the limitation is indefinite.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2 and 6-22 are rejected under 35 U.S.C. 102(e) as being anticipated by SURACE et al. (6,334,103 B1) hereinafter referenced as SURACE.

As per **claim 1**, as best understood in view of the rejection under 35 USC 101 (see above), SURACE discloses voice user interface with personality (title), comprising:

“an automatic speech recognition (ASR) mechanism operable to recognise spoken input from a user and to provide information corresponding to a recognised spoken term to a control mechanism” (Fig. 4 and col. 8, lines 12-54, ‘ASR/NL software perform automatic speech recognition and natural language speech processing’; col. 6, lines 26-52, ‘commands (including control mechanism) that a voice user interface...can understand when spoken by a user’, ‘speech recognized (information)’),

“said control mechanism being operable to determine whether said information is to be used as input to a current context, and conditional on said information being determined to be

input for said current context, to provide said information to said current context, wherein said control mechanism is further operable to switch context conditional on said information being determined not to be input for said current context” (Figs. 6-8 and col. 8, lines 7-67, ‘controlling the voice user interface’; Figs. 6-8, show that the recognized command(s) (read on information to used as input to a current context) is/are processed with certain processing determined by the flow chart(s) that includes conditional branches (switch context), which is read on the claim; Figs. 13A, 13B and 14A show the flow control of the interactions with confirmation, which can be also read on the claim).

As per **claim 2** (depending on claim 1), SURACE further discloses “a speech generation mechanism for converting at least part of any output to speech” (col. 17, lines 28-33, ‘TTS/recorded speech output software’).

As per **claim 6** (depending on claim 1), SURACE further discloses “an application management mechanism operable to integrate external services with the spoken language interface mechanism” (Fig. 4 and col. 8, lines 55-62, ‘application 410 is in communication with a LAN or internet 404’, ‘provides access to email...’ and ‘transmits a request for service that can be served by remote computers’ (external services)).

As per **claim 7** (depending on claim 1), SURACE further discloses “at least one said application is a software application”, (Fig. 4 and col. 8, lines 55-62, ‘application 410 ... provides access to email...calendar (software applications)’).

As per **claim 8** (depending on claim 1), SURACE further discloses “at least one of the automatic speech recognition mechanism and the control mechanism are implemented by computer software”, (col. 8, lines 12-13, ‘ASR/NL software’).

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As per **claim 9** (depending on claim 1), as best understood in view of the rejection under 35 USC 112 2nd, see above, SURACE further discloses “provide said information to said at least one application when non-directed dialogue is provided as spoken input from a user”, (col. 8, lines 55-62, ‘application 410 is in communication with a LAN or the Internet 404 ... provides access to email, voice mail, calendar... (interpreted as non-directed dialogue)’; col. 21, lines 35-38, ‘does not necessarily have a predefined and certain path’, ‘works with a variety of potential pathways’, ‘user event can be unpredictable’, which can also be read on the claimed limitation).

As per **claim 10** (depending on claim 1), SURACE further discloses “a notification manager”, (col. 10, lines 51-63, ‘provides context-sensitive help (notification)’ that ‘includes informing (notifying) the user of the present state of the user’s session and available options...’, wherein the corresponding informing mechanism is read on notification manager).

As per **claim 11**, it recites computer system. As best understood in view of the rejection under 35 USC 101 (see above), the rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitation(s) as claim 1.

As per **claim 12**, it recites a program element. As best understood in view of the rejection under 35 USC 101 (see above), the rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitation(s) as claim 1.

As per **claim 13**, it recites a computer program product on a carrier medium. As best understood in view of the rejection under 35 USC 101 (see above), the rejection is based on the same reason as described for claim 12, because the claim recites same or similar limitation(s) as claim 12.

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As per **claim 14**, it recites a computer program product on a carrier medium. As best understood in view of the rejection under 35 USC 101 (see above), the rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitation(s) as claim 1.

As per **claim 15** (depending on claim 14), the rejection is based on the same reason as described for claim 9, because the claim recites same or similar limitation(s) as claim 9.

As per **claim 16** (depending on claim 14), SURACE further discloses “the carrier medium includes at least one of the following set of media: [a radio-frequency signal, an optical signal, an electronic signal,] a magnetic disc or tape, solid-state memory, an optical disc, a magneto-optical disc, a compact disc and a digital versatile disc”, (col. 30, lines 44-49, ‘a computer system (inherently include hard-disc and RAM/ROM) includes a memory (e.g. volatile and non-volatile memory) (corresponding to carrier medium)’).

As per **claim 17**, it recites a spoken language system. As best understood in view of the rejection under 35 USC 101 (see above), the rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitations as claim 1.

As per **claim 18** (depending on claim 17), the rejection is based on the same reason as described for claim 9, because the claim recites same or similar limitation(s) as claim 9.

As per **claim 19** (depending on claim 17), the rejection is based on the same reason as described for claim 2, because the claim recites same or similar limitation(s) as claim 2.

As per **claim 20**, it recites a method. As best understood in view of the rejection under 35 USC 101 (see above), the rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitations as claim 1.

As per **claim 21** (depending on claim 20), the rejection is based on the same reason as described for claim 9, because the claim recites same or similar limitation(s) as claim 9.

As per **claim 22** (depending on claim 20), the rejection is based on the same reason as described for claim 2, because the claim recites same or similar limitation(s) as claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5 and 2324 are rejected under 35 U.S.C. 103(a) as being unpatentable over SURACE in view of KUO et al. (US 6,418,440 B1) hereinafter referenced as KUO.

As per **claim 3** (depending on claim 1), SURACE does not expressly disclose “a session management mechanism operable to track the user's progress when performing one or more tasks”. However, the feature is well known in the art as evidenced by KUO who discloses system and method for performing automated dynamic dialogue generation (title), comprising ‘dialogue manager’ to ‘control the dialogue flow’, and ‘log system and dialogue information’ to ‘trace dialogue sessions’ (col. 10, lines 19-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify SURACE by specifically providing a dialogue management mechanism, as taught by KUO, for the purpose (motivation) of tracing dialogue session (KUO: col. 10, line 24).

As per **claim 4** (depending on claim 3), SURACE in view of KUO further discloses “to track one or more reached position when one or more said tasks and/or dialogues are being performed and subsequently to reconnect the user at one said reached position” (KUO: col. 10, lines 48-55, ‘dialogue history, and keeping a log of dialogue sessions’, ‘go back (reconnect) to a previous part (reached position) of the session’).

As per **claim 5** (depending on claim 1), SURACE does not expressly disclose “an adaptive learning mechanism operable to personalise a response of the spoken language interface mechanism according to the user”. However, the feature is well known in the art as evidenced by KUO who further discloses that ‘this information results in User Behavior Log Files 19, which may be used to automatically (adaptively) update the user profile as the system learns more about the user's habits, and also as the various databases involved are updated’ (KUO: col. 6, lines 52-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify SURACE by specifically providing a mechanism of automatically leaning user habits and updating user profile, as taught by KUO, for the purpose (motivation) of more efficiently delivering the requested services and/or offering more readily updated information (KUO: col. 6, lines 62-64).

As per **claim 23** (depending on claim 20), the rejection is based on the same reason as described for claim 4, because the claim recites same or similar limitation(s) as claim 4.

As per **claim 24** (depending on claim 23), the rejection is based on the same reason as described for claim 4, because the claim recites same or similar limitation(s) as claim 4.

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Conclusion

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Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richmond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
July 19, 2006


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER